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| EXAMINER | |
|---|---|
| FOX, BRYAN J | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2686 | |

DATE MAILED: 03/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/020,094 | COVERSTONE, THOMAS E. | |
| | Examiner | Art Unit | |
| | Bryan J. Fox | 2686 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *01 November 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *10-47* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *10-47* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-24, 26-37 and 39-47 are rejected under 35 U.S.C. 102(b) as being anticipated by Ito (US005999126A).

Regarding claim 10, Ito discloses a system for positioning a mobile phone where a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "wireless communication system that is used with a wireless communication device and a position location system, the wireless communication device being capable of communicating with the position location system, the wireless communication system comprising: a memory device for storing position location data for the wireless communication device; a processor for determining trends in the position location data by recalling stored information from the memory device and processing the recalled information." Data signals may be provided from the PHS base station pertaining to traffic jam information or closed street information (see column 10, lines 40-65), which reads on the claimed, "transmitter for transmitting targeted broadcasts to the wireless communication device at least based on the determined trends."

Regarding claim 11, Ito discloses a system for positioning a mobile phone where a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "wireless communication system that is used with a wireless communication device and a position location system, the wireless communication device being capable of communicating with the position location system, the wireless communication system comprising: a memory device for storing transaction data for the wireless communication device; a processor for determining trends in the transaction data by recalling stored information from the memory device and processing the recalled information." Data signals may be provided from the PHS base station pertaining to traffic jam information or closed street information (see column 10, lines 40-65), which reads on the claimed, "transmitter for transmitting targeted broadcasts to the wireless communication device at least based on the determined trends."

Regarding claim 12, Ito discloses the transmissions are received from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcasts are transmitted to wireless communication devices currently located in a specific area."

Regarding claim 13, Ito discloses that the position can be calculated from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcasts are transmitted to wireless communication devices predicted to be located in a specific area."

Regarding claim 14, Ito discloses a system for positioning a mobile phone where a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "wireless communication system that is used with a wireless communication device and a position location system, the wireless communication device being capable of communicating with the position location system, the wireless communication system comprising: a memory device for storing position location data for the wireless communication device; a processor for recalling stored information from the memory device and processing the recalled information." Data signals may be provided from the PHS base station pertaining to traffic jam information or closed street information (see column 10, lines 40-65), which reads on the claimed, "transmitter for transmitting targeted broadcasts to the wireless communication device at least based on the processed information."

Regarding claim 15, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "the memory device also stored transaction data for the wireless communication device," wherein the previous history is locations determined with the system and therefore reads on transaction data.

Regarding claim 16, Ito discloses various transactions such as ordering music (see column 11, lines 44-64), which reads on the claimed, "the transaction data includes usage transactions, responses to broadcasts, requests for information, or any combination thereof."

Regarding claim 17, Ito inherently provides support for the memory device also storing preselected user information or preferences as one of ordinary skill in the art would recognize the need to store an identifier of the mobile device, which reads on the claimed, "preselected user information," wherein the broadest reasonable interpretation in light of the specification of user information would include an identifier of the mobile device.

Regarding claim 18, Ito discloses a system for positioning a mobile phone where a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "wireless communication system that is used with a wireless communication device and a position location system, the wireless communication device being capable of communicating with the position location system, the wireless communication system comprising: a memory device for storing position location data for the wireless communication device; a processor for recalling stored information from the memory device and processing the recalled information." Data signals may be provided from the PHS base station pertaining to traffic jam information or closed street information (see column 10, lines 40-65), which reads on the claimed, "transmitter for transmitting targeted broadcasts to the wireless communication device at least based on the current location of the wireless communication device."

Regarding claim 19, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "the memory device also stored transaction data for the wireless

communication device," wherein the previous history is locations determined with the system and therefore reads on transaction data.

Regarding claim 20, Ito discloses various transactions such as ordering music (see column 11, lines 44-64), which reads on the claimed, "the transaction data includes usage transactions, responses to broadcasts, requests for information, or any combination thereof."

Regarding claim 21, Ito inherently provides support for the memory device also storing preselected user information or preferences as one of ordinary skill in the art would recognize the need to store an identifier of the mobile device, which reads on the claimed, "preselected user information," wherein the broadest reasonable interpretation in light of the specification of user information would include an identifier of the mobile device.

Regarding claim 22, Ito discloses a system for positioning a mobile phone where a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "wireless communication system comprising: a memory device capable of storing data for a plurality of wireless communication devices; a processor for recalling stored information from the memory device and processing the recalled information." Data signals may be provided from the PHS base station pertaining to traffic jam information or closed street information (see column 10, lines 40-65), which reads on the claimed, "transmitter for transmitting a targeted broadcast to each wireless communication device in the targeted broadcast audience."

Regarding claim 23, Ito discloses the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcast audience is selected from the plurality of wireless communication devices."

Regarding claim 24, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "the stored data comprises position location data for at least one wireless communication device."

Regarding claim 26, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "the memory device also stored transaction data for the wireless communication device," wherein the previous history is locations determined with the system and therefore reads on transaction data.

Regarding claim 27, Ito discloses various transactions such as ordering music (see column 11, lines 44-64), which reads on the claimed, "the transaction data includes usage transactions, responses to broadcasts, requests for information, or any combination thereof."

Regarding claim 28, Ito inherently provides support for the memory device also storing preselected user information or preferences as one of ordinary skill in the art would recognize the need to store an identifier of the mobile device, which reads on the claimed, "preselected user information."

Regarding claim 29, Ito discloses the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcast

audience is limited to wireless communication devices currently located in a specific area," wherein since the data is broadcasted, there is inherently a limited range of the broadcast.

Regarding claim 30, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcast audience is limited to wireless communication devices predicted to be located in a specific area."

Regarding claim 31, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the processor selects the targeted broadcast audience by determining trends in the stored data for at least one wireless communication device."

Regarding claim 32, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the processor selects the targeted broadcast audience by determining trends in the position location data for at least one wireless communication device."

Regarding claim 33, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the

processor selects the targeted broadcast audience by determining trends in the transaction data for at least one wireless communication device."

Regarding claim 34, Ito discloses the use of broadcasting advertisements (see column 11, lines 14-24), which reads on the claimed, "the targeted broadcast comprises an advertisement."

Regarding claim 35, Ito discloses a system for positioning a mobile phone where a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "method for sending a targeted broadcast in a wireless communication system comprising: storing data for a plurality of wireless communication devices; processing the stored data." Data signals may be provided from the PHS base station pertaining to traffic jam information or closed street information (see column 10, lines 40-65), which reads on the claimed, "selecting a targeted broadcast audience form the processed data, wherein the targeted broadcast audience comprises at least one wireless communication device."

Regarding claim 36, Ito discloses the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcast audience is selected from the plurality of wireless communication devices."

Regarding claim 37, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "the stored data comprises position location data for at least one wireless communication device."

Regarding claim 39, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39), which reads on the claimed, "the stored data comprises transaction data relating to at least one wireless communication device," wherein the previous history is locations determined with the system and therefore reads on transaction data.

Regarding claim 40, Ito discloses various transactions such as ordering music (see column 11, lines 44-64), which reads on the claimed, "the transaction data includes usage transactions, responses to broadcasts, requests for information, or any combination thereof."

Regarding claim 41, Ito inherently provides support for the memory device also storing preselected user information or preferences as one of ordinary skill in the art would recognize the need to store an identifier of the mobile device, which reads on the claimed, "preselected user information."

Regarding claim 42, Ito discloses the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the targeted broadcast audience is limited to wireless communication devices currently located in a specific area," wherein since the data is broadcasted, there is inherently a limited range of the broadcast.

Regarding claim 43, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the

targeted broadcast audience is limited to wireless communication devices predicted to be located in a specific area."

Regarding claim 44, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the processor selects the targeted broadcast audience by determining trends in the stored data for at least one wireless communication device."

Regarding claim 45, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the processor selects the targeted broadcast audience by determining trends in the position location data for at least one wireless communication device."

Regarding claim 46, Ito discloses a current position may be estimated to some degree from a previous history (see column 10, lines 28-39) and the data is transmitted from a PHS base station (see column 10, lines 40-65), which reads on the claimed, "the processor selects the targeted broadcast audience by determining trends in the transaction data for at least one wireless communication device."

Regarding claim 47, Ito discloses the use of broadcasting advertisements (see column 11, lines 14-24), which reads on the claimed, "the targeted broadcast comprises an advertisement."

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 25 and 38 rejected under 35 U.S.C. 103(a) as being unpatentable over Ito in view of Marlevi et al (US005572221A).

Regarding claims 25 and 38, Ito fails to disclose the position location data comprises frequent routes traveled by at least one wireless communication device.

In a similar field of endeavor, Marlevi et al disclose a system that uses the regular patterns of movement that mobile phone users fallow every day of the week to predict one's next location (see column 5, lines 49-67), which reads on the claimed, "frequent routes traveled by at least one wireless communication device.

It would have been obvious to a person of ordinary skill in the art at the time of the invention to modify Ito with Marlevi et al to include the above use of predicted location in order to take appropriate actions before the mobile reaches a new location as suggested by Marlevi et al (see column 5, lines 57-67).

### *Response to Arguments*

Applicant's arguments with respect to claims 10-47 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryan J. Fox whose telephone number is (571) 272-7908. The examiner can normally be reached on Monday through Friday 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Feild can be reached on (571) 272-4090. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOSEPH FEILD
SUPERVISORY PATENT EXAMINER

Bryan Fox
February 23, 2006